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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,047	01/08/2001	Takuji Goda	K-1951	6751

7590 05/01/2003

KANESAKA AND TAKEUCHI
1423 Powhatan Street
Alexandria, VA 22314

EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/01/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

Office Action Summary

Application No.

09/755,047

Applicant(s)

GODA ET AL.

Examiner

Andrew T Piziali

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of: .
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. After careful consideration of the arguments presented in the Appeal Brief filed 3/24/2003 the examiner has withdrawn the rejections, and the finality, of the Office Action mailed 10/8/2002. In the Appeal Brief the applicant notes that independent claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Ueoka and under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Ota, while claim 10, which depends from claim 8, was rejected under 35 U.S.C. 102(b) as being anticipated by Tsai. The examiner asserts that claim 8 was incorrectly grouped with the 35 U.S.C. 103(a) rejections in the Office Action mailed 10/8/2002. The following Office Action has been written to correct the previous deficiency.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,808,715 to Tsai et al. (hereinafter referred to as Tsai).

Regarding claims 8 and 10, Tsai discloses a glass substrate for a display comprising an alkali-containing glass substrate (12b), a TiO₂-SiO₂ composite layer (13b), an ITO film (14b), a TiO₂-SiO₂ film (15b), and an electrode film (10a) in that enumerated order (Figure 2 and column 4, lines 3-14). Tsai does not mention the surface electrical resistance of the TiO₂-SiO₂ film

Art Unit: 1775

(15b), but considering that the film comprises a highly resistant composite of $\text{TiO}_2\text{-SiO}_2$ (column 4, lines 15-32 and column 6, lines 16-18), and since the material is substantially identical to the material suggested by the applicant (see applicant's specification on page 11, lines 10-13), the film would inherently possess an electrical resistance within the range of 1.0×10^6 to 1.0×10^{16} Ω/\square even after a heating process at 550C for 1 hour.

Regarding claims 8 and 10, Tsai also discloses that a conventional glass substrate for a display comprises an alkali-containing glass substrate (2b), a SiO_2 layer (3b), an ITO film (4b), a SiO_2 or TiO_2 film (not shown, see column 1, lines 51-59), and an electrode film (2a plus 3a plus 4a) in that enumerated order (Figure 1 and column 1, lines 13-65). Tsai does not mention the surface electrical resistance of the SiO_2 or TiO_2 film (not shown), but considering that the film comprises SiO_2 or TiO_2 , which are identical materials to the material suggested by the applicant (see applicant's specification on page 11, lines 10-13), the film would inherently possess an electrical resistance within the range of 1.0×10^6 to 1.0×10^{16} Ω/\square even after a heating process at 550C for 1 hour.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive. The applicant asserts that the ITO film of Tsai does not constitute the barrier film of the currently claimed invention, because Tsai suggests that the ITO film is used as the electrode of the article rather than being used as a barrier film. The examiner respectfully disagrees. The examiner asserts that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

Art Unit: 1775

intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The examiner asserts that the prior art structure is capable of performing the intended use claimed by the current applicant, therefore, the prior art reads on the currently pending claims.

Conclusion

5. Applicant's amendment on 8/29/2002 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (703) 306-0145. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the

Art Unit: 1775

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.

gtp

atp
April 29, 2003

Andrew T Piziali
Examiner
Art Unit 1775

Deborah Jones
DEBORAH JONES
SUPERVISORY PATENT EXAMINER